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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,898	02/24/2004	Thomas Brinkman	103864.100 US2	1032
28089	7590	11/16/2005		
WILMER CUTLER PICKERING HALE AND DORR LLP 399 PARK AVENUE NEW YORK, NY 10022			EXAMINER MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER

3623

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,898

Applicant(s)

BRINKMAN ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/9/05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 are presented for examination.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff (U.S. Patent No. 5,594,638).

Iliff discloses a computer-assisted method of providing clinical, pharmaceutical, and health benefit information and advice using a computer system, a caller, and one or more operators, said method comprising of:

[Claim 1] (a) prompting the caller to select a service by one of the computer system and the one or more operators (col. 20, line 66 through col. 21, line 6; col. 27, lines 25-41);

(b) selecting, by the caller, a service (col. 27, line 25 through col. 28, line 34);

(c) validating, by the computer system, that the caller is an eligible caller (col. 20, lines 48-65; col. 28, lines 38-67);

(d) accessing, via the computer system, one or more of a member information database, a clinical information database, a pharmaceutical information database, and a health benefit information database (col. 12, lines 50-61; col. 41, lines 34-45);

(e) generating, via the computer system, one or more of clinical advice, pharmaceutical advice, and health benefit advice (col. 35, line 10 through col. 42, line 9);

[Claim 2] (a) updating, via the computer system, the member information database (col. 12, line 62 through col. 13, line 18); and

(b) reporting, via the computer system, a call report (col. 12, line 62 through col. 13, line 5; col. 21, line 66 through col. 22, line 5);

[Claim 4] wherein said generating step (e) further comprises the step of alerting, via the computer system, the caller of more or more outbound interventions (col. 12, line 62 through col. 13, line 18);

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[Claim 6] wherein said generating step (e) further comprises the step of referring, via the computer, the caller to a health professional (col. 41, lines 34-45);

[Claim 9] wherein said one or more of clinical advice, pharmaceutical advice, and health benefit advice comprises pre-recorded messages (col. 35, line 10 through col. 42, line 9).

As per claims 1, 3, and 4 in particular, Iliff does not explicitly teach the use of an operator as an intermediary between the computer system and the caller; however, Iliff does allude to the existence of such an operator. First, Iliff describes the prior art Ask-A-Nurse program where a caller speaks directly with a nurse (col. 1, lines 41-63). Iliff's own invention implements hierarchical staffing so that an operator, nurse, or physician is available to address unforeseen circumstances (col. 6, lines 45-55). While Iliff explicitly states that the operator or nurse is never required to make any medical decisions (col. 6, lines 54-55), Iliff seems to imply that the operator, nurse, or physician is available to act as an intermediary between the computer system and the caller. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to transfer data between the caller and the computer system via the operator (including a nurse or physician) in order to provide a human touch to help callers feel more emotional support as well as comfort in the fact that they may have a one-to-one conversation with a human being knowledgeable about his/her medical concerns. In a society as automated as ours, many people are relieved to still find a human voice

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instead of a computerized voice at the other end of the phone line, especially regarding delicate issues such as one's health.

As per claim 5, Iliff does not expressly teach the step of writing drug prescriptions (including refills or renewals); however, official notice is taken that it is old and well-known in the art to have prescriptions called in by a doctor's office on a patient's behalf. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable Iliff's invention to write, via the computer system, one or more of drug prescriptions, drug prescription refills, and drug prescription renewals in order to save both a patient and a health plan sponsor time and money that would otherwise be required to set up an appointment for the patient to physically see a doctor and/or travel to the hospital and then pay for such expenses. For example, if a patient has established a history of allergy and sinus problems which have previously been diagnosed by a member physician, it is more cost and time efficient for the patient to be authorized a medicine refill (such as for Claritin-D, which is commonly prescribed to allergy sufferers) automatically by the computer system so that the patient does not waste unnecessary travel time nor incur further costs for a doctor visit which will inevitably result in a routine prescription refill. Obviously, Iliff's system would not be enabled to randomly prescribe medicine to a patient who had never consulted a doctor; therefore, the prescription writing capability would only be utilized in more routine, and therefore safer, situations.

As per claim 7, Iliff saves a patient's history (col. 41, lines 57-61), but he doesn't explicitly include a record of advice given in previous sessions with the caller; however,

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Iliff's invention stores the patient's history with the purpose of being able to give the most accurate future diagnoses. In this respect, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to maintain a record of advice given by the computer system in order to help assess in the future why recommended treatments may or may not have worked. Also, if the computer system later decides that it gave incorrect advice, it is crucial that the computer system be able to give more accurate advice in light of the previously supplied advice in order to prevent any serious medical consequences to the patient/caller. Furthermore, such analysis may lead the system to detect any errors in its logic used to dole out advice and may therefore prevent serious medical consequences from affecting future callers.

As per claim 8, Iliff refers patients to doctors and he provides advice directly to the callers (col. 41, lines 12-45), but he doesn't explicitly disclose sending this advice directly to the doctors. Again, just like Iliff's computer system, doctors make their most accurate diagnoses when they have as detailed of a patient history as possible. Consequently, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to forward Iliff's advice to the doctor to which the caller is referred so that the doctor is as best equipped as possible to make an accurate diagnosis and treatment proposition when the caller comes in for an appointment in person.

[Claims 10-18] Claims 10-18 recite limitations already addressed by the rejection of claims 1-9 above; therefore, the same rejection applies.

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[Claims 19-20] Claims 19 and 20 recite limitations already addressed by the rejection of claims 1-9 above; therefore, the same rejection applies.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

November 12, 2005